

REMARKS

Claims 1 and 5-8 are pending in this application. Claims 1, 5 and 7 are independent.

In paragraph 2 of the Office Action, claims 1, 5 and 6 were rejected as unpatentable over U.S. Patent No. 3,234,564 (Chujfi).

Claim 1 is directed to an improved reversible zipper fly cover comprising a zipper having a first attachment strip opposite a second attachment strip. First and second panel zipper flaps are respectively connected to the first and second attachment strips by first and second attachment seams, *each of the first and second attachment strips being devoid of an enclosing hem*. First and second fly cover flaps are formed by respectively attaching the first and second panel zipper flaps to first and second panels by first and second fly cover finish seams.

Each of Chujfi's zipper attachment strips is enclosed by a respective hem 40 (Fig. 3, column 3 lines 1-8). Enclosing the attachment strips in the hem produces a tailored appearance, which Chujfi apparently desired. Accordingly, Chujfi teaches away from the invention of claim 1.

Chujfi's hem creates at least one additional layer of fabric for each side of the reversible zipper assembly as compared to the claimed invention. Chujfi's additional layers of hem fabric, at least one on each side of the reversible zipper assembly, make Chujfi's garment bulkier than a garment according to the present invention. For the present invention, absence of bulkiness in the groin area means that the garment is more comfortable to wear, and does not present an artificial bulge that might attract ridicule to the garment's wearer. These are advantages of the present invention over the prior art and must be considered in assessing the issue of obviousness under the "totality of the record" test stated in *In re Chu*.

Additional disadvantages of Chujfi's zipper fly relative to the claimed zipper fly are:

- when the pants are formed of a stiff, bulky fabric such as denim, Chujfi's additional fabric layers make it more likely that the sewing needle will break during stitching of the zipper fly;
- Chujfi's additional layers of fabric require slower sewing, which is bad for mass production, since more time on the sewing machine contributes to the cost of the garment; and
- Chujfi's additional layers require additional steps during constructions, which increases production cost.

At the bottom of page 3 of the Office Action, the Examiner stated,

It would have been obvious to have provided the first and second attachment strips being devoid of an enclosing hem or having an enclosing hem, because as long as the attachment strips are attached to the first and second zipper flaps and provide a reversible fly structure[,] the presence or not of an enclosing hem does not [a]ffect the reversibility of the zipper structure and therefore can be there or not.

The Examiner's argument amounts to considering only reversibility of the claimed zipper fly as important, and then using that as a justification for ignoring structural differences between the claimed zipper fly and Chujfi's zipper fly. This is pure error.

As explained above, ease of wearing and ease of manufacturing are also important aspects of a zipper fly. The claimed zipper fly is dramatically different than Chujfi's zipper fly when considered with respect to wearability and manufacturability. **Applicant protests the Examiner's failure to consider wearability and manufacturability as important.**

Moreover, *In re Kotzab*, 217 F.3d 1365, 1371 (Fed. Cir. 2000) teaches that,

Particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination *in the manner claimed*. (emphasis added)

The skilled artisan, considering Chujfi, would have followed Chujfi's construction, and thus been unable to arrive at the claimed invention. The Examiner has failed to explain why the skilled artisan would modify Chujfi to arrive at the claimed invention; thus, **the Examiner has failed to carry her burden of setting forth a *prima facie* case of obviousness.**

At the top of page 4 of the Office Action, the Examined continued,

There is no discussion in the originally filed disclosure detailing the criticality or advantage of the first and second attachment strips being devoid of an enclosing hem.

There is no legal requirement that the specification explicitly state all advantages of a disclosed structure or that an applicant be precluded from arguing those advantages during prosecution of the patent application.

"To require [an applicant] ... to include evidence and arguments in the specification ... would be to require patent applicants to divine the rejections the PTO will proffer when patent applications are filed." *In re Chu*, 66 F.3d 292, 298 (Fed. Cir. 1995) (none of the arguments would require any change in the construction of the disclosed apparatus). "We found no cases supporting the position that a patent applicant's evidence and/or arguments traversing a § 103 rejection must be contained within the specification. There is no logical support for such a proposition as well, given that obviousness is determined by the totality of the record including, in some instances most significantly, the evidence and arguments proffered during the give-and-take of ex parte patent prosecution." *Id.* at 299.

See also *In re Zenitz*, 333 F.2d 924, 928 (C.C.P.A. 1964)(evidence and arguments that claimed compound minimized side effects of hypotensive activity must be considered because this undisclosed property would inherently flow from use of compound as a tranquilizer). "[T]he mere failure of a patentee to realize all the benefits and possibilities of his invention is not fatal."

Id. at 927. “By disclosing in a patent application a device that inherently performs a function, operates according to a theory, or has an advantage, a patent applicant necessarily discloses that function, theory or advantage even though he says nothing concerning it. The application may later be amended to recite the function, theory or advantage without introducing prohibited new matter.” *In re Reynolds*, 443 F.2d 384, 388 (C.C.P.A. 1971); *In re Smythe*, 480 F.2d 1376, 1384 (C.C.P.A. 1973).

Applicant has repeatedly provided case law supporting its position that advantages of a claimed invention do not need to be set forth in the specification. The Examiner, however, does not explain why this case law is inapplicable, and instead continues to attach significance to the absence of the advantages in the specification. ***The Examiner’s position is contrary to the law.***

At the bottom of page 5 of the Office Action, the Examiner similarly stated,

Examiner notes that the attachment strips being devoid of an enclosing hem is not discussed in the specification detailing why it is critical to the invention or an advantage to the invention over other embodiments.

Applicant does not find a need for discussion of criticality of features anywhere in 35 USC 112, or any other part of the patent law (35 USC), patent code (37 CFR) or even the MPEP. If Examiner believes that a specification must include a discussion of “critical to the invention” features, beyond disclosing them in a manner that would enable one of ordinary skill in the art to make or use the invention, then applicant respectfully requests that the Examiner indicate the source of the “critical to the invention” discussion requirement for the specification. Since Examiner has not provided any authority for her “critical to the invention” discussion requirement for the specification, applicant believes that there is no such requirement, and **Examiner must withdraw her rejections based on this non-existent requirement.**

Claim 5 is a method claim generally corresponding to claim 1, and is not made obvious by Chujfi for the reasons described above. Claim 6 depends from claim 5, and so incorporates its features that patentably distinguish from Chujfi.

Withdrawal of the rejection of claims 1, 5 and 6 under 35 USC 103 is requested.

In paragraph 3 of the Office Action, claims 7 and 8 were rejected under 35 USC 103 as being unpatentable over Chujfi and GB Patent No. 2,153,656 (Vaghela).

Claim 7 is directed to a reversible garment with a reversible fly, comprising first and second panel zipper flaps respectively attached to first and second panels of the reversible garment, the second panel zipper flap having the same shape as the first panel zipper flap. A zipper having a reversible traveler guide is located between the first and second panel zipper flaps, the zipper having first and second attachment strips respectively affixed to the first and second panel zipper flaps by first and second attachment seams, each of the first and second attachment strips being devoid of an enclosing hem.

Vaghela was cited as showing a zipper with a reversible traveler guide. The proper combination of Chujfi and Vaghela is to replace Chujfi's two zipper traveler guides with Vaghela's one reversible traveler guide, which, while an improvement that reduces bulk, does not eliminate the bulk due to the additional layers of Chujfi's enclosing hems. Accordingly, claim 7 is patentably distinguished from any proper combination of Chujfi and Vaghela.

Claim 8 depends from claim 7, and so incorporates its features that patentably distinguish from Chujfi.

Withdrawal of the rejection of claims 7-8 under 35 USC 103 is requested.

It is respectfully requested that this patent application pass to issue. A Notice of Allowance is solicited.

Please call the undersigned if there are any questions.

Respectfully submitted,

Date: January 22, 2007

Brenda Pomerance

Brenda Pomerance
Reg. No. 36,894

Address:
Law Office of Brenda Pomerance
260 West 52 St. Ste. 27B
New York, NY 10019
voice/fax 212 245-3940